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| 09/941,432      | 08/28/2001  | Wolfram Arnold       | EFIM0280            | 7327             |

31408 7590 12/08/2004

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| EXAMINER |
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LEROUX, ETIENNE PIERRE

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| ART UNIT | PAPER NUMBER |
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2161

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|  |   |   |  |
|--|---|---|--|
| <p align="center"><b>Office Action Summary</b></p> | <p>Application No.</p> <p align="center">09/941,432</p> | <p>Applicant(s)</p> <p align="center">ARNOLD ET AL.</p> |  |
|  | <p>Examiner</p> <p align="center">Etienne P LeRoux</p>  | <p>Art Unit</p> <p align="center">2161</p>              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                               | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9/16/04</u> . | 6) <input type="checkbox"/> Other:  |

***Continued Examination***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/16/2004 has been entered.

***Claims Status***

Claims 1-16 and 18 are pending. Claims 17 and 19-25 are cancelled.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-16 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites "A method for converting a first file in a binary Raster Document Object (RDO) format to a second file in a second format." The specification does not include a clear and concise written

Art Unit: 2161

description of the process of converting a first file in a RDO format to a second file in a second format.

Claim 9 includes language similar to claim 1 and is rejected for the same reasons.

Claims 2-8 and 10-16 and 18 are rejected for being dependent from a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 in the preamble includes the following language "A method for converting a first file in a binary Raster Document Object (RDO) format to a second file in a second format." The scope of the invention cannot be determined because the second format is not ascertainable from the preamble of claim 1 nor from the body of claim 1. It is difficult to determine if one or more of the following are comprise a second file in a second format: 1) page image files, (2) output page, (3) document pages. For purposes of this Office Action, examiner will assume that the above three instances are comparable and are collectively the second file in the second format.

Claim 9 includes language similar to claim 1 and is rejected for the same reasons.

Claims 2-8 and 10-16 and 18 are rejected for being dependent from a rejected base claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 9-14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 4,897,799 issued to LeGall et al (hereafter LeGall) in view of US Pat No 6,715,127 issued to Eshbach et al (hereafter Eshbach), as best examiner is able to ascertain.

Claims 1 and 9:

LeGall discloses:

- reading the first file [Fig 1, 14, col 3, lines 43-55]
- decoding the document format of the first file to identify the data [Fig 1, 16]
- sorting the identified data on a document page basis [Fig 1, 18]
- placing the page image files for each document page on the associated output page according to the assembly instructions in the sorted data [Fig 1, 15]

LeGall discloses a document format but is silent regarding a RDO. Eshbach discloses a RDO [col 2, lines 13-26]. It would have been obvious to one of ordinary skill in then art at the time the invention was made to modify LeGall to include a RDO as taught by Eshbach for the purpose of interfacing with a well-known printer format. The skilled artisan would have been motivated to improve the invention of LeGall per the above for the purpose of improving the marketability of a software product.

Art Unit: 2161

Claims 2 and 10:

LeGall discloses transferring the identified data into a data structure representation in a memory [inherent in Fig 1]

Claims 3 and 11:

LeGall discloses wherein the data comprise page-invariant data that applies to all the document pages [col 3, lines 25-30]

Claims 4, 12 and 18:

LeGall discloses wherein said page-invariant data comprise any of header and footer messages, their location, or font selection or margin specifications [col 3, lines 43-58]

Claims 5 and 13:

Eshbach discloses wherein the page image files comprise TIFF format files [paragraph 34]

Claims 6 and 14:

LeGall discloses storing discloses output pages in a memory when all pages have been processed [inherent in Fig 1]

Claims 7, 8, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of LeGall and Eshbach and further in view of Pub No 2002/0067498 to Chapman, as best examiner is able to ascertain.

Claims 7 and 15:

The combination of LeGall and Eshbach discloses the elements of claim 1 as noted above. The combination of LeGall and Eshbach fails to disclose a PDF format. Chapman

Art Unit: 2161

discloses a PDF format [paragraphs 20 and 21]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of LeGall and Eshbach to include a PDF format as taught by Chapman for the purpose of interfacing with a popular page description language [paragraphs 20 and 21]. The skilled artisan would have been motivated to improve the invention of LeGall and Eshbach per the above for the purpose of improving the marketability of the marketability of a software product.

Claims 8 and 16:

The combination of LeGall and Eshbach discloses the elements of claim 1 as noted above. Furthermore, Chapman discloses wherein the page image files comprise PostScript files [paragraphs 20 and 21].

***Response to Arguments***

Applicant's arguments filed 9/16/2004 have been fully considered but they are not persuasive.

**Applicant Argues:**

Applicant states in the fourth paragraph on page 7, "Claims 1-16 and 18 have been rejected under 35 U.S.C. § 102(e) as anticipated by Chapman. The claimed invention describes methods and apparatus for converting a first file in a binary RDO format to a second file in a second format. Unlike the claimed invention, Chapman does not pertain to methods and apparatus for converting RDO format files, as such files are described in this application. Because the cited reference does not describe or suggest the claimed invention, applicants respectfully request that the rejections of amended independent claims 1 and 9 be withdrawn.

Art Unit: 2161

Because all other claims depend from claims 1 and 9, applicant respectfully requests the rejection of claims 1-16 and 18 be withdrawn.

**Examiner Responds:**

Examiner is not persuaded. Claims 1-16 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 in the preamble includes the following language "A method for converting a first file in a binary Raster Document Object (RDO) format to a second file in a second format." The scope of the invention cannot be determined because the second format is not ascertainable from the preamble of claim 1 nor from the body of claim 1. Nevertheless, notwithstanding the indefiniteness of the claim language, examiner in above Office Action, rejects the claimed method of converting a first file in a first format to a second file in a second format over the combination of LeGall and Eshbach. LeGall discloses the following in column 2, lines 10-20:

The present invention is a method for enabling format independent communications of visual information between and among diverse systems such as computers, work stations, and terminals. In particular, the inventive method enables the transmission of visual information, such as the data comprising a raster display, from an originating system which uses a first native format to a receiving system which utilizes a second format native to it.

Examiner maintains that the combination of LeGall and Eshbach does "pertain to methods and apparatus for converting RDO format files" per applicant's comment in supra paragraph.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (571) 272-4022.

0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (571) 272-4023.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

12/03/2004

  
SAFET METJAHIC  
REVISORY PATENT EXAMINER  
TECHNOLOGY 2100